

REMARKS/ARGUMENTS

By this response, Claims 1, 25, and 49 have been amended. No claims have been added or canceled. Hence, Claims 1-72 are pending in the application. All issues raised in the Final Office Action mailed February 25, 2005 are addressed herein. In view of the comments provided hereinafter, reconsideration and allowance is respectfully requested.

SUMMARY OF THE REJECTIONS/OBJECTIONS

The issues raised in the Final Office Action mailed on February 5, 2005 are summarized below. Each of these issues is discussed hereinafter.

1. Claims 1-13, 16-19, 25-37, 40-43, 49-62, and 65-67 were rejected under 35 U.S.C. § 103(a) as being unpatentable, allegedly, over Landsman et al., U.S. Patent No. 6,317,761 (hereinafter “Landsman”), in further view of Eillbott et al., U.S. Patent No. 6,553,393 (hereinafter “Eillbott”).
2. Claims 14, 15, 38, 39, 63, and 64 were rejected under 35 U.S.C. § 103(a) as being unpatentable, allegedly, over Landsman, further in view of Ackermann, Jr. et al., U.S. Patent No. 6,606, 653 (hereinafter “Ackermann”)—but not Eillbott.
3. Claims 20, 44, and 68 were rejected under 35 U.S.C. § 103(a) as being unpatentable, allegedly, over Landsman and Eillbott in further view of Underwood, U.S. Patent No. 6,704, 873 (hereinafter “Underwood”).
4. Claims 21-23, 45-47 and 69-71 were rejected under 35 U.S.C. § 103(a) as being unpatentable, allegedly, over Landsman and Ellibott in further view of Markus, U.S. Patent No. 6,499, 042 (hereinafter “Markus”).

5. Claims 24, 48, and 72 were rejected under 35 U.S.C. § 103(a) as being unpatentable, allegedly, over Landsman and Ellibott in further view of Shapiro et al., U.S. Patent No. 5,991, 810 (hereinafter “Shapiro”)

THE REJECTIONS BASED ON THE PRIOR ART

A. REJECTION OF CLAIMS 1-13, 16-19, 25-37, 40-43, 49-62, AND 65-67 UNDER 35 U.S.C. §103(a).

Claims 1-13, 16-19, 25-37, 40-43, 49-62, and 65-67 were rejected under 35 U.S.C. § 103(a) as being unpatentable, allegedly, over Landsman, further in view of Eillbott. It is respectfully submitted that Claims 1-13, 16-19, 25-37, 40-43, 49-62, and 65-67 are patentable for at least the reasons provided hereinafter.

CLAIM 1

The Office Action asserts that Landsman discloses a method, computer-readable medium, and computer system for allowing a porthole engine to deliver unrequested content to users that access requested content through a porthole engine. The Office Action acknowledges that Landsman fails to teach or suggest that a porthole engine generates data. The Office Action alleges that Eillbott discloses the generation of data by a porthole engine. The Office Action asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Landsman in view of Eillbott.

In an effort to expedite allowance of the claims, Claim 1 has been amended. As amended, Claim 1 now requires the porthole engine to respond to the initial request by sending data to the client **before** the requested content is requested from the origin server. There is no teaching or suggestion, in either Landsman or Eillbott, that a proxy server (the alleged porthole

engine) sends data to a client **before** the proxy server requests data from an alleged origin server.

Landsman discloses, at col. 8, lines 17-24, that a request from a client PC is routed to a proxy server, which, in turn, directs that request onward to the advertisement web server. Only **after** the advertisement files have been requested from the advertisement web server and sent to the proxy server does the proxy server provide the advertisement files to the client PC that made the request. There is no mention of the proxy server providing any data other than the advertisement files to the client PC.

Eillbott discloses, at col. 2, lines 23-30, that a proxy server transcodes HTML returned from an origin server, then generates an embedded object reference list, then adds the list to the data stream (the transcoded HTML) that is to be returned to a client, and then returns the data stream to the client. Thus, it is only **after** the proxy server has requested the HTML from the origin server that the proxy server sends the data stream to the client that requested the HTML. There is no mention of the proxy server providing any data other than the data stream to the client.

Thus, neither Landsman nor Eillbott teaches, discloses, or suggests “before the requested content is requested from the origin server, said porthole engine responding to said initial request by sending to said client data generated by the porthole engine wherein the data causes said requested content and said unrequested content to appear on a display screen of said client” as recited in Claim 1. In order for a *prima facie* case of obviousness to be established under 35 U.S.C. 103, the combined references must, at least when considered in combination, teach or suggest all of the limitations of the claims that are alleged to be obvious. Even assuming, arguendo, that Landsman and Eillbott could be combined, Landsman and Eillbott

still do not teach, disclose, or suggest all of the limitations of Claim 1. Thus, Claim 1 is patentable over Landsman and Eillbott, taken individually or in combination.

Claims 2-13 and 16-19 depend from Claim 1 and therefore include all of the distinguished limitations of Claim 1. Thus, Claims 2-13 and 16-19 are patentable over Landsman and Eillbott for at least the reasons given above with reference to Claim 1.

Claim 25 is a “computer readable medium” version of Claim 1. Claim 49 is a system claim with limitations similar to those described above with reference to Claim 1. The remaining claims depend, directly or indirectly, on Claims 1, 25 or 49. Therefore, all of the remaining claims are patentable over Landsman and Eillbott, taken individually or in combination, for the reasons given above with respect to Claim 1. In addition, each of these claims includes one or more additional limitations that independently render it patentable over the art of record.

B. REJECTION OF CLAIMS 14, 15, 38, 39, 63, AND 64 UNDER 35 U.S.C. § 103(a)

Claims 14, 15, 38, 39, 63, and 64 were rejected under 35 U.S.C. § 103(a) as being unpatentable, allegedly, over Landsman further in view of Ackermann.

However, the Office Action acknowledges that Landsman fails to teach or suggest that a porthole engine generates data, as required by Claim 1 and therefore Claims 14 and 15 as well. The Office Action does not even allege that Ackerman teaches or suggests that a porthole engine generates data. The Office Action alleged that Eillbott discloses that a porthole engine generates data, but the Office Action did not cite Eillbott in the rejection of Claims 14, 15, 38, 39, 63, and 64.

By virtue of their dependence from Claim 1, Claims 14 and 15 include all the limitations recited in Claim 1. As explained above, Landsman and Ackerman, taken

individually or in combination, fail to teach or suggest at least one limitation required by Claim

1. Thus, Claims 14 and 15 are patentable over Landsman and Ackerman.

Claims 38, 39, 63, and 64 include similar limitations to Claims 14 and 15, except Claims 38 and 39 refer to a computer-readable medium, and Claims 63 and 64 refer to a system. Therefore, Claims 38, 39, 63, and 64 are patentable over Landsman and Ackermann for at least the reasons provided herein with respect to Claims 14 and 15.

C. REJECTION OF CLAIM 20, 44 AND 68 UNDER 35 U.S.C. § 103(a)

Claims 20, 44 and 68 and were rejected under 35 U.S.C. § 103(a) as being unpatentable, allegedly, over Landsman and Eillbott in further view of Underwood. By virtue of its dependence from Claim 1, Claim 20 includes all the limitations recited in Claim 1. As set forth herein with respect to Claim 1, Landsman, either alone or in combination with Eillbott, fails to teach or suggest at least one limitation required by Claim 1. The Office Action does not even allege that Underwood teaches or suggests these missing limitations. Thus, Claim 20 is patentable over Landsman, Eillbott, and Underwood, taken individually or in combination.

Claims 44 and 68 recite similar limitations to Claim 20, except Claim 44 relates to a computer-readable medium and Claim 68 relates to a system. Therefore, Claims 44 and 68 are also patentable over Landsman, Eillbott, and Underwood, taken individually or in combination. In addition, Claims 20, 44, and 68 introduce additional limitations that independently render them patentable over Landsman, Eillbott, and Underwood.

D. REJECTION OF CLAIMS 21-23, 45-47 AND 69-71 UNDER 35 U.S.C. § 103(a)

Claims 21-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable, allegedly, over Landsman and Eillbott in further view of Markus. Claims 21-23 depend from Claim 1 and

include all the limitations recited in Claim 1. As set forth herein with respect to Claim 1, Landsman, either alone or in combination with Eillbott, does not teach one or more limitations required by Claim 1. Therefore, a combination of Markus with Eillbott and Landsman cannot provide all features or steps recited in Claims 21-23. Further, Claims 21-23 recite additional limitations not taught or suggested by Landsman, Eillbott, and Markus, either taken alone or in combination. However, due to the fundamental differences already identified for the claim upon which Claims 21-23 depend, a separate discussion of those limitations are not included at this time.

Claims 45-47 and 69-71 include similar limitations to Claims 21-23, except that Claims 45-47 refer to a computer-readable medium, and Claims 69-71 refer to a system. Therefore, Claims 45-47 and 69-71 are patentable over Landsman, Eillbott, and Markus for at least the reasons provided herein with respect to Claims 21-23.

E. REJECTION OF CLAIMS 24, 48 AND 72 UNDER 35 U.S.C. § 103(a)

Claim 24 was rejected under 35 U.S.C. § 103(a) as being unpatentable, allegedly, over Landsman and Eillbott in further view of Shapiro. Claim 24 depends from Claim 1 and includes all the limitations recited in Claim 1. As set forth herein with respect to Claim 1, Landsman, either alone or in combination with Eillbott, does not teach one or more limitations required by Claim 1. Therefore, a combination of Shapiro with Eillbott and Landsman cannot provide all features or steps recited in Claim 24. Further, Claim 24 recites additional limitations not taught or suggested by Landsman, Eillbott, or Shapiro, either taken alone or in combination. However, due to the fundamental differences already identified for the claim upon which Claim 24 depends, a separate discussion of those limitations are not included at this time.

Claims 28 and 72 recite similar limitation to Claim 24, except that Claim 28 refers to a computer-readable medium, and Claim 72 refers to a system. Therefore, Claims 28 and 72 are patentable over Landsman, Eillbott, and Shapiro for at least the reason provided herein with respect to Claim 24.

D. REMAINING CLAIMS

The remaining pending claims not discussed so far are dependent claims that depend on an independent claim discussed above. Because each of the dependent claims includes the limitations of the claims upon which they depend, the dependent claims are patentable for at least those reasons given above for the independent claims. Removal of the rejections with respect to the dependent claims and allowance of the dependent claims is respectfully requested. In addition, the dependent claims introduce additional limitations that independently render them patentable. However, due to the fundamental differences already identified for the independent claim, a separate discussion of those limitations are not included at this time.

III. CONCLUSIONS & MISCELLANEOUS

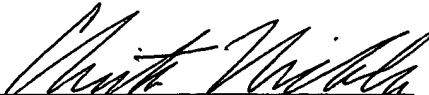
For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450

on May 25, 2005

by


Judy Paradoski